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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2002-0527.02

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on January 13, 2006

Signature Ronald K. Aust

Typed or printed name Ronald K. Aust

Application Number

10/625,383

Filed

July 23, 2003

First Named Inventor

Christopher A. Adkins, et al.

Art Unit

3621

Examiner

E. Augustin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record.
Registration number _____
- attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 Reg. No. 36,735



Signature

Ronald K. Aust

Typed or printed name

317-894-0801

Telephone number

January 13, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
 Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of)
Christopher A. Adkins, et al.) Group: 3621
Serial No.: 10/625,383)
Filed: July 23, 2003)
Title: METHOD FOR PROVIDING IMAGING)
SUBSTANCE FOR USE IN AN IMAGING DEVICE)
VIA A VIRTUAL REPLENISHMENT) Examiner: E. Augustin

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the present Attachment to Pre-Appeal Brief Request For Review.

REMARKS

Claims 1-90 are pending in the present patent application. Claims 1-90 stand rejected.

Applicants believe that claims 1-90 are patentable over the cited references, and that the rejection of claims 1-90 is clearly in error, for at least the reasons set forth below.

Claims 1-24, 29-54, 59-70, and 75-86 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takemoto, et al., U.S. Patent Application Publication No. 2002/0012541 A1 (hereinafter Takemoto) in view of Ruder, U.S. Patent No. 4,967,207.

Applicants have summarized Takemoto and Ruder as set forth in Applicants' Reply under 37 C.F.R. 1.116, mailed October 17, 2005, beginning at the upper portion of page 20 and ending near the bottom of page 21.

Claim 1 is directed to a method for providing a virtual replenishing of a supply item with an imaging substance. Claim 1 recites, in part, providing a first supply item containing an actual supply of the imaging substance, the actual supply including a licensed amount of the imaging substance and a surplus amount of the imaging substance. Claim 1 also recites wherein if the verification key received from the database corresponds to the first key stored in the memory associated with the first supply item, then performing the step of allocating at least a portion of the surplus amount of the imaging substance contained in the first supply item for use.

As set forth in Applicants' Reply under 37 C.F.R. 1.116, beginning at the bottom of page 21, and ending at the bottom of page 25, Applicants respectfully submit the combination of Takemoto and Ruder would not yield Applicants' invention of claim 1, that Takemoto in view of Ruder, taken alone or in combination, do not disclose, teach, or suggest the subject matter of claim 1, and that hence, claim 1 is not obvious over Takemoto in view or Ruder.

In contrast to claim 1, Takemoto discloses determining whether a license is available for the cartridge or not, and if not, the user is offered the opportunity to pay a fee, and if not, the user is subsequently offered to pay a fee two months later, or otherwise asked to accept that some functions of the Takemoto image forming apparatus 100 will be restricted (page 14, paragraph 223 to page 15, paragraph 234). Functions may be restricted if the user does not pay the fee (page 15, paragraph 239), but printer operation is allowed without a license until 30% remaining toner is detected. Once 30% remaining toner is reached, operation of the printer is stopped, and the user is warned to get a license immediately or exchange the cartridge (page 16, paragraphs 240-243).

Thus, in contrast to providing a first supply item containing an actual supply of the imaging substance, the actual supply including a licensed amount of the imaging substance and a surplus amount of the imaging substance, Takemoto discloses a supply item (the cartridge) having a portion of which may be used prior to obtaining the license, e.g., 70%. If the license is paid for, the user may use the full 100% of the toner.

Accordingly, as acknowledged by the Examiner, Takemoto does not disclose, teach, or suggest a surplus amount of imaging substance contained in the Takemoto supply item, at least of portion of which may be allocated for use if the verification key received from the database corresponds to the first key stored in the memory associated with the first supply item, as recited in claim 1.

Ruder discloses a print assembly 10 having a reservoir container 14 that provides ink to an ejector 12 (col. 5, lines 63-68). Reservoir container 14 may be refilled by drawing a vacuum in reservoir container 14, and connecting a colorant supply line 54 to refill needle 26, wherein colorant is drawn into container 14 from a colorant supply bottle 56 by the vacuum (col. 8, lines 23-37).

Thus, in contrast to a first supply item containing an actual supply of the imaging substance, the actual supply including a licensed amount of the imaging substance and a surplus amount of the imaging substance, any corresponding Ruder surplus amount is not contained in the first supply item, but rather is contained in another device, colorant supply bottle 56.

Since the Ruder colorant supply bottle 56 is used to refill the Ruder reservoir container 14, it is clear that Ruder discloses physically refilling a reservoir container 14 (the first supply item),

using a second item, colorant supply bottle 56, in contrast to a virtual replenishing of the supply item, via a surplus amount of imaging substance *contained in the supply item*, at least of portion of which may be allocated for use if the verification key received from the database corresponds to the first key stored in the memory associated with the first supply item, as recited in claim 1.

Stated differently, there is no surplus amount of imaging substance contained in the corresponding Ruder first supply item (reservoir container 14) that may be allocated for use if a verification key corresponds to a key stored in a memory associated with the supply item.

Thus, Takemoto and Ruder, taken alone or in combination, do not disclose, teach, or suggest the subject matter of claim 1, and would not yield Applicants' claimed invention, and hence, claim 1 is not obvious over Takemoto in view of Ruder.

Regarding the Examiner's assertion that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references, Applicants submit that in order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. However, as acknowledged by the Examiner, Takemoto does not disclose, teach, or suggest the use of a surplus of toner in the Takemoto cartridge to refill the cartridge. In addition, Ruder does not disclose, teach, or suggest the use of a surplus of ink in the corresponding Ruder first supply item. Rather, Ruder employs a separate colorant supply bottle to physically replenish the corresponding first supply item (reservoir container 14). Thus, since all of the claim limitations are not disclosed, taught, or suggested by Takemoto and Ruder, taken alone or in combination, claim 1 is not obvious over Takemoto in view of Ruder.

In addition, Applicants disagree with the Examiner's characterization of Applicants' invention (see the Examiner's Response to Arguments in the Final Office Action, mailed August 16, 2005, beginning at the bottom portion of page 2 through the upper portion of page 3). The Examiner's characterization is overly broad, and clearly does not reflect the limitations recited in claim 1.

For example, the Examiner broadly asserts that a "principal enabler" of Applicants' invention is the ability to monitor the amount of toner and to "take corrective action" if the remaining amount falls below a particular threshold, which may be to replenish the toner cartridge with a "licensed surplus amount," and that the system "performs due diligence." However, claim 1 does not recite the broadly asserted "principle enabler," much less the broad assertions being to "take corrective action," and to perform "due diligence." In addition, Takemoto and Ruder, taken alone or in combination, clearly do not disclose, teach, or suggest a "licensed surplus amount."

Rather, Applicants respectfully submit that the asserted combination is based on hindsight reconstruction, wherein the characterization was constructed in an overly broad manner in an attempt to capture Applicants' claimed invention as being obvious, by using Applicants' claimed invention as a template to piece together the teachings of Takemoto and Ruder. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In addition, regarding the Examiner's statement that the type of corrective action is taken is a design choice, a finding of obvious design choice is precluded where the claimed structure and the function it performs are different from the prior art. *In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992); *In re Chu*, USPQ2d 1089 (Fed. Cir. 1995). As acknowledged by the Examiner, Takemoto does not disclose, teach, or suggest using a surplus of toner to refill the cartridge. Ruder also does not disclose use of a surplus of ink in the corresponding Ruder first supply item to refill the first supply item. Rather than a virtual replenishment based on a first supply item containing an actual supply of the imaging substance, the actual supply including a licensed amount of the imaging substance and a surplus amount of the imaging substance, Ruder uses a second item to physically refill the corresponding first item.

Also, as set forth above, Takemoto and Ruder, taken alone or in combination do not disclose, teach, or suggest wherein if the verification key received from the database corresponds to the first key stored in the memory associated with the first supply item, then performing the step of allocating at least a portion of the surplus amount of the imaging substance contained in the first supply item for use, as recited in claim 1.

Thus, the claim 1 structure and functions performed thereby are different from the prior art.

Further, the virtual replenishing of a supply item in accordance with Applicants' invention does not require additional components, and the cost and complexity associated therewith, such as the Ruder colorant supply line 54, refill needle 26, and separate colorant supply bottle 56, because with the Applicants' invention, the supply item itself contains a licensed amount of the imaging substance *and* a surplus amount of the imaging substance for use in virtual replenishing.

Claims 13, 29, 30, 31, 43, 59, and 75 are believed allowable for substantially the same reasons as set forth above with respect to claim 1.

Claims 2-12, 14-24, 32-42, 44-54, 60-70, and 76-86 are believed allowable due to their dependence upon otherwise allowable respective base claims 1, 13, 29, 30, 31, 43, 59, and 75.

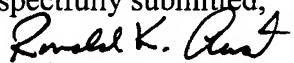
Dependent claims 25-28, 55-58, 71-74, and 87-90 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takemoto in view of Walmsley, Simon Robert, U.S. Patent No. 6,816,968 B1 (hereinafter, Walmsley). Applicants have summarized Walmsley as set forth in Applicants' Reply under 37 C.F.R. 1.116, on page 35. Applicants respectfully request reconsideration of the rejection of claims 25-28, 55-58, 71-74, and 87-90 in view of the following.

Walmsley does not make up for the deficiency of Takemoto and Ruder as applied to base claims 13, 43, 59, and 75. Accordingly, claims 25-28, 55-58, 71-74, and 87-90 are believed allowable due to their dependence upon their otherwise allowable respective base claims.

For the foregoing reasons, Applicants submit that the present application is in condition for allowance in its present form, and it is respectfully requested that a Notice of Allowance be issued in due course.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorize that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (317) 894-0801.

Respectfully submitted,

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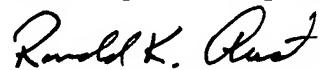
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Ronald K. Aust, Reg. No. 36,735

Name of Registered Representative



Signature

January 13, 2006

Date